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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/994,385	11/26/2001	Jean-Luc Bouvier	MIC-16 (P50-0065)	7265

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EXAMINER

JOHNSTONE, ADRIENNE C

ART UNIT

PAPER NUMBER

1733

DATE MAILED: 01/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/994,385

Applicant(s)

BOUVIER ET AL.

Examiner

Adrienne C. Johnstone

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 November 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 7, 16 and 21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8-15 and 17-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-6, 8-15, and 17-20, drawn to a tire apparatus for driving a vehicle during periods of low pressure and normal tire pressure wherein the friction members to prevent relative movement between tire and rim are on the bead seats of the rim, classified in class 152, subclass 158.
 - II. Claim 21, drawn to a tire apparatus for driving a vehicle during periods of low pressure and normal tire pressure wherein the friction members to prevent relative movement between tire and rim are on the beads of the tire, classified in class 152, subclass 158.
 - III. Claims 7 and 16, drawn to a tire apparatus for driving a vehicle during periods of low pressure and normal tire pressure wherein the friction members to prevent relative movement between tire and rim are on both the bead seats of the rim and the beads of the tire, classified in class 152, subclass 158.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are distinct inventions: Invention I does not require the friction members on the tire beads of Invention II, and Invention II does not require the friction members on the rim bead seats of Invention I.
3. Inventions I-II and III are related as tire apparatus employing the friction members on one of the rim bead seats and tire beads and tire apparatus employing the combination of both types of friction members. Inventions in this relationship are distinct if it can be shown that the tire apparatus including the combination of both types of friction members as claimed does not

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require the particulars of the tire apparatus including a single type of friction members as claimed for patentability (MPEP § 806.05(c)). In the instant case, the tire apparatus including the combination of both types of friction members as claimed does not require the particulars of the tire apparatus including a single type of friction members as claimed because there is evidence (independent claims 1 and 10 with rim bead seat friction members but no tire bead friction members and independent claim 21 with tire bead friction members but no rim bead seat friction members) that neither type of friction members is the sole basis for patentability of the tire apparatus including the combination of both types of friction members.

4. Because these inventions are distinct for the reasons given above and the search required for Group I (152/384 for example) is not required for Group II, restriction for examination purposes as indicated is proper.

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Specifically, see paragraphs 12 and 13 below which recite numerous patents disclosing friction members on the rim bead seats without also having friction members on the tire beads, evidence of separate inventive effort (MPEP 808.02). It should be noted that there is burden for searching and examining a combination with respect to its subcombinations because a search and examination of a combination AB would not require a search and examination for both A and B individually. For example, if there is evidence of synergy or cooperation between A and B or unexpected results for the combination of A and B, evidence of A and B individually would not distinguish over the combination and therefore it would not be necessary to search and examine A or B individually. Of course, once allowable subject matter has been determined, rejoinder of

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the claims including the combination will be considered if these claims incorporate the allowable subject matter.

6. During a telephone conversation with Neil Pierotti on December 31, 2002 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-6, 8-15, and 17-20. Affirmation of this election must be made by applicant in replying to this Office action. Claims 7, 16, and 21 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.
7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Specification

8. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

9. The abstract of the disclosure is objected to because it is more than 150 words in length.

Correction is required. See MPEP § 608.01(b).

One way to overcome this objection would be to delete "is provided. The tire apparatus" in line 1 of the abstract.

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Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

12. Claims 1-6, 8-15, and 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted prior art in view of Lacour (5,891,279), British Patent Specification 283,660, Kraft (2,427,216), Macklin (1,566,028), Japanese Patent Application 62-275802, German Patent Application L 20502 II/63d, Japanese Patent Application 5-169901, Harrington et al. (4,269,251), and French et al. (4,148,348).

The only difference between the prior art tire apparatus and the claimed tire apparatus is the presence of the plurality of friction members on at least one of the bead seats to prevent relative rotational movement between the tire and rim, as evidenced by applicants (specification p. 2 lines 9-18) and Lacour (col. 1 line 5 - col. 4 line 3) for example; however, it is well known to provide such friction members on rim bead seats of pneumatic tires in order to counteract the natural tendency of the tire to creep around the wheel rim (rotate relative to the wheel rim) when the vehicle is in motion, as evidenced by British Patent Specification 283,660 (p. 1 line 12 - 65:

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anti-creep lugs in the form of axially extending corrugations (alternating ridges and depressions) in the bead seats), Kraft (col. 1 line 1 - col. 2 line 29: anti-creep lugs in the form of transverse serrations in a portion of the bead seats (other portion constitutes bead seal zones) and screws through the bead seats), Macklin (p. 1 line 10 - p. 2 line 2: anti-creep lugs in the form of axially extending knobs in a portion of the bead seats (other portion constitutes bead seal zones)), JP 802 (abstract, figures: portion of bead seat surfaces roughened to prevent slippage of the tire on the rim (other portion constitutes bead seal zones)), German Patent Application L 20502 II/63d (lines 18-35: steel granules or spheres sprayed on bead seat surfaces to roughen them, providing raised portions and recesses, determined through oral translation), JP '901 (abstract and translation paragraphs 0001-0014: bead seats dotted with rough membrane layer of sand or shell particles in a matrix resin to prevent rim slip (undotted portion of bead seats constitutes air seal zones), Harrington et al. (col. 1 lines 4-17, col. 2 lines 33-43, col. 3 lines 1-8, and col. 3 lines 56-60: preventing creep under low tire inflation pressure), and French et al. (col. 1 lines 5-31 and col. 12 lines 52-56: preventing creep under low tire inflation pressure by roughening the surface of the groove portion of the bead seat (other portion constitutes air seal zones)), for example. It would therefore have been obvious to one of ordinary skill in the art to provide the rim bead seats of the prior art tire apparatus with such well known friction members in order to counteract the natural tendency of the tire to creep around the wheel rim (rotate relative to the wheel rim) when the vehicle is in motion.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following references disclose further examples of anti-creep friction members on rim bead seats: Bullard (1,295,266); White (1,340,094); McClevey (1,396,515); Buckwalter (2,620,010); Araya (3,784,260); Japanese Patent Application 62-163802; Japanese Patent

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Application 6-135202; Japanese Patent Application 6-211001; and published PCT application WO 01/25030.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adrienne C. Johnstone whose telephone number is (703)308-2059.

The examiner can normally be reached on Monday-Friday, 10:00AM-6:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Ball can be reached on (703)308-2058. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9311 for regular communications and (703)872-9310 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.

Adrienne Johnstone
January 10, 2003

Adrienne C. Johnstone
Primary Examiner
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